UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,017	02/07/2001	Handong Wu	NETAP009	5629

7590   06/03/2004

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EXAMINER
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ART UNIT	PAPER NUMBER
2141	11

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _07 February 2001_.
2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-28_ is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) _1-28_ is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on _20 April 2001_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a) ☐ All b) ☐ Some * c) ☐ None of:
   1. ☐ Certified copies of the priority documents have been received.
   2. ☐ Certified copies of the priority documents have been received in Application No. _____.
   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date. _4-6_.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Detail Action

1.   This Office Action is in response to the application 09/779,017 filed on 02/07/2001. Claims 1-28 are presented for examination.
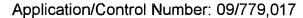
Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3.   Claims 1, 3-11, 14, 16-19, 21-22, 25-26 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Bandera et al. (US 6,332,127), herein after referred as Bandera.

4.   As to claim 1, Bandera teaches a method for providing advertising to a mobile device, comprising:

receiving a request for content from the handheld computer *(a Web server 24 receiving a Web page request from a mobile Web client 21)* (Fig. 2, C7: L9-10);

associating an advertisement with the request for content *(Web server generates the requested Web page with the selected advertising objects included there within)*;

sending the requested content to the handheld computer for display on the screen of the computer *(the requested Web page is then served/transmitted to the mobile Web client)* (Bandera, C7: L28-31); and

sending the associated advertisement to the handheld computer for playing over an audio output device of the handheld computer *(the selected advertising objects within the requested Web page 26, which may include text files, audio files, video files, image files and the like, can be sent from the Web server 26 and played/displayed at the mobile Web client 21)* (Bandera, C5: L22-26 and C7: L28-31).

5.   As to claim 3, Bandera teaches the method of claim 1, wherein the network is the Internet *(the mobile Web client 21 is in communication with the Web server 24 via a computer network, such as the Internet 25 in Fig. 2)* and receiving a request for content comprises receiving an HTTP request (Bandera, Fig. 2, C1: L18-22 and C45-59).

6.   As to claim 4, Bandera teaches the method of claim 3, wherein associating an advertisement with a request for content comprises sending a link to an advertisement server along with the requested content *(the advertising object 32 might contain a hypertext link 36 to an advertising server)* (Bandera, C7: L56-67).

7.   As to claim 5, Bandera teaches the method of claim 4, wherein the requested content is sent from a server hosting a Web site *(i.e., the Web server 24 in Fig. 2)*.

8.   As to claims 6-7, Bandera teaches the method of claim 1, wherein the request for content identifies the source as a handheld computer establishing a wireless connection with the network *(based on the user location information obtained via GPS or via a telephone system included in an HTTP header part of the Web page request, the Web server can identify the source as a mobile device such as a PDA, a handheld computer, a "smart" mobile phone, etc., establishing a wireless connection with the network)* (Bandera, C6: L56-67, C7: L1-16).

9.   As to claim 8, Bandera teaches the method of claim 7, wherein sending the associated advertisement comprises sending the advertisement in-band with the requested Web content *(the Web server generates the requested Web page with the selected advertising object included there within to send to the mobile Web client)* (Bandera, C7: L28-31).

10.   As to claim 9, Bandera teaches the method of claim 7, wherein sending the requested content and associated advertisement comprises utilizing a wireless access protocol *(since the mobile Web client communicates with the Web server via a wireless/mobile network, hence, it inherently utilizes a wireless access protocol to send request and receive response from the network)*.

11.   As to claims 10-11, Bandera teaches the method of claim 1 further comprising receiving information about the handheld computer requesting content and associating an advertisement with the request for content comprises associating an advertisement based on the information received about the handheld computer *(i.e., the Web server may select an advertising object based on the retrieved mobile Web client location information and time of day the request was received)* (Bandera, C7: L9-26).

12.   As to claim 14, Bandera teaches the method of claim 1, wherein sending the associated advertisement comprises sending the advertisement in an audio format (Bandera, C5: L21-26).

13.   Claims 16-19 and 21-22 are corresponding claims of method claims 1, 3, 5 and 9-11; therefore, they are rejected under the same rationale.

14.   Claim 25 is a corresponding computer program product claim of method claim 1; therefore, it is rejected under the same rationale.

15.   Claims 26 and 28 are corresponding system claims of method claims 1 and 5;

therefore, they are rejected under the same rationale.

Claim Rejections - 35 USC § 103

16.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

17.   Claims 2, 15, 20 and 27 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Bandera, in view of Jong (US 6,173,250).

18.   As to claims 2 and 15, Bandera teaches the method of claim 1, but does not

explicitly teach that sending the associated advertisement comprises sending the

advertisement in a text format that can be converted to speech.

In the related art, Jong teaches an apparatus and method for speech-text-

transmit communication over data networks includes speech recognition devices and

text to speech conversion devices that translate speech signals input to the terminal to

text and text data received from a data network into speech output signals, wherein the

receiving terminal receives text data *(i.e., the advertisement in a text format)* and may

immediately display the text data and/or translate it into speech output signals using the text to speech conversion device (Jong, Abstract, Fig. 6, C5: L22-33 and C7:L61 – C8:L3).

Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made to combine the teachings of Bandera and Jong to send the advertisement in a text format that can be converted to speech since such methods were conventionally employed in the art to allow the system to transmit the advertisement in a text format at a lower speed and therefore a lower bandwidth since text data packets representing speech are streaming at a lower data rate when compared with voice data packets.

19.   Claims 20 and 27 are corresponding claims of method claims 2 and 15; therefore, they are rejected under the same rationale.

20.   **Claims 12 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bandera, in view of Bull et al. (US 5,901,287), herein after referred as Bull.**

21.   As to claim 12, Bandera teaches the method of claim 1 but does not explicitly teach that associating an advertisement with the request for content comprises associating an advertisement based on the content requested.

In a related art, Bull teaches an information aggregation and synthesization system and process to access, poll, and retrieve data from various local data stores that

is synthesized, customized, personalized and localized to meet the information resource requests specified by user via the network interface device, wherein if a certain web page is requested, a particular advertisement will be inserted based on the content of the requested/existing web page and sent to the user with the requested web page for display (Bull, C4: L7-27 and L63-67, C5: L1- 10 and C13: L32-58).

Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made to combine the teachings of Bandera and Bull to associate an advertisement based on the content request since such methods were conventionally employed in the art to allow the system generating and providing advertisements related to the requested content to be pushed to the recipients in order to provide effective online advertising responsive to the content of the requested information by eliciting greater attention and interests from the recipients, hence, to increase the advertising value of the online communications.

22.   Claim 23 is a corresponding claim of method claim 12; therefore, it is rejected under the same rationale.

23.   **Claims 13 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bandera, in view of Dodrill et al. (US 6,738,803), herein after referred as Dodrill.**

24.   As to claim 13, Bandera teaches the method of claim 1, but does not explicitly teaches that sending the associated advertisement comprises sending a visual warning when an audio channel of the handheld computer is turned off.

In the related art, Dodrill teaches a proxy browser providing voice enabled web application audio control for mobile devices, wherein the proxy driver stores for each corresponding user device capabilities data that specifies functions that the user device is able to perform (Dodrill, C10: L23-35). The proxy browser also includes IP and PSTN network interface cards each are able to perform basic telephony functions, such as detect an on-hook or off-hook condition by the corresponding user device, detect incoming phone call or message, notify the corresponding user device accordingly by ringing the device or flashing an alert message *(i.e., sending a visual/alert message when the audio is off)* and send/receive audio signals (Dodrill, C11: L22-32).

Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made to combine the teachings of Bandera and Dodrill to send a visual warning when an audio channel of the handheld computer is turned off since such methods were conventionally employed in the art to notify the user accordingly about the incoming message when the audio function of the device is turned off *(e.g., flashing or vibrating the mobile phone to alert/warn user that there is an incoming call when the sound is turned off)* so user can take appropriate action.

25.   Claim 24 is a corresponding claim of method claim 13; therefore, it is rejected under the same rationale.

26.   Further references of interest are cited on Form PTO-892, which is an attachment to this office action.

27.   A shortened statutory period for reply to this action is set to expire THREE (3) months from the mailing date of this communication. See 37 CFR 1.134.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (703) 305-8190.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (703) 305-4003. The fax phone number for the organization is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Quang N. Nguyen

LE HIEN LUU
PRIMARY EXAMINER